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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/975,586 | 10/11/2001 | Peter C. Meltzer | 70207/48,913-CON | 9855 |

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EXAMINER

AULAKH, CHARANJIT

ART UNIT PAPER NUMBER

1625

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,586

Applicant(s)

MELTZER ET AL.

Examiner

Charanjit S. Aulakh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. According to paper filed on March 14, 2005, the applicants have filed a RCE and furthermore, have amended claims 22-27 and added new claims 28-33.
2. Claims 22-33 are now pending in the application.

Specification

3. The amendment filed on Oct.28, 2002 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The applicants have amended specification to claim priority to earlier applications. This is a new matter since the inventive entity is different in all those applications. Moreover, there is not even a single example of 3-alpha tropanes in the prior applications such as 09/875,523, now patent 6,670,375. The only exemplified 3-alpha isomers are of oxabicyclo octanes (see examples 15 and 16 in patent 6,670,375). Therefore, the applicants are not entitled to the earlier priority date of Nov. 3, 1995. The earlier priority date of the instant application is May 12, 1999 based on the provisional application.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

4. Applicant's arguments filed on March 14, 2005 have been fully considered but they are not persuasive regarding obviousness rejections over Kuhar reference(U.S. Patent 5,496,953) and Davies reference (U.S. Patent 6,008,227). The applicants have

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amended claims to overcome prior art rejections over Kuhar reference (U.S. Patent 6,358,492 0 as well as obviousness rejection over Clarke reference (U.S. Patent 3,813,404). The examiner also agrees with the applicants arguments regarding written description requirement. The specification is now objected. In regard to obviousness rejections over Kuhar reference and Davies reference, the examiner does not agree with the applicant's arguments that combination of these two references with Kuhar (Pat. 6,358,492) will not be obvious to one skilled in the art to prepare the instant 3-alpha trpoane derivatives. All three references are directed to 3-aryltropane derivatives having binding affinity for dopamine and serotonin uptake sites. As stated earlier in previous office actions, Kuhar (Pat 492) provides the motivation to prepare the instant selective dopamine ligands (3-alpha isomers of tropane derivatives) by modifying non-selective dopamine and serotonin ligands (3-beta isomers of tropane derivatives) of Kuhar (Pat 953) and Davies (Pat 227) since Kuhar (Pat 492) teaches the selectivity of 3-alpha isomers for dopamine transporter over 3-beta isomers (see table 3).

Conclusion

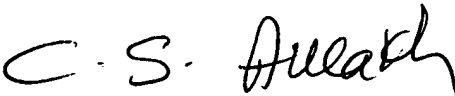
5. Rejections of claims 22-33 under 35 U.S.C. 103(a) over Kuhar and Davies references are maintained for the reasons of record.
6. Rejection under 35 U.S.C. 102(e) is now withdrawn in view of amendments.
7. Rejection under 35 U.S.C. 112, first paragraph is now withdrawn in view of persuasive arguments.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is

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(571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charanjit S. Aulakh
Primary Examiner
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